



16 JAN 2009

UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents
United States Patent and Trademark Office
P.O. Box 1450
Alexandria, VA 22313-1450
www.uspto.gov

61214
FOX ROTHSCHILD, LLP
Elan Pharma International Limited
2000 Market Street
Philadelphia, PA 19103

In re Application of
LE ROY *et al*
U.S. Application No.: 10/583,845
PCT No.: PCT/FR2004/003104
Int. Filing Date: 02 December 2004
Priority Date: 13 December 2003
Attorney Docket No.: PF030187
For: IMAGE DISPLAY SCREEN AND
METHOD FOR ADDRESSING SAID
SCREEN

DECISION

This decision is in response to applicants' petition under 37 CFR 1.47 filed 10 November 2008.

BACKGROUND

On 11 June 2008, the DO/EO/US mailed a Notification of Missing Requirements Under 35 U.S.C. 371 (Form PCT/DO/EO/905) indicating that an oath or declaration in compliance with 37 CFR 1.497(a) and (b) and a surcharge fee was required. Applicants were given two months to respond with extensions of time available.

On 10 November 2008, applicants filed a petition under 37 CFR 1.47(a) which was accompanied by, *inter alia*, a \$200.00 petition fee; a two-month extension fee; a \$130.00 surcharge fee; a declaration signed by two of the three named inventors; required fees; a declaration of Florence Pac; and other documentary evidence (with accompanying English translations when required) in support of the petition.

DISCUSSION

Applicants claim that joint inventor Fabian Ammardji refuses to cooperate in the above-captioned application and filed the subject petition in response to the Form PCT/DO/EO/905 mailed 11 June 2008.

It is first noted that a three-month extension of time is required since the petition was not filed until 10 November 2008. The three-month extension fee of \$1,110 has been charged to Deposit Account No. 07-0832 as authorized. The two-month extension fee of \$490.00 has been credited back to counsel's Deposit Account.

A petition under 37 CFR 1.47(a) requires: (1) the petition fee; (2) factual proof that the missing joint inventor cannot be located or refuses to cooperate; (3) a statement of the last known address of the nonsigning joint inventor; (4) and an oath or declaration executed by the signing joint inventor on their behalf and on behalf of the nonsigning joint inventor. Item (2) is not yet complete.

Regarding item (2), the 37 CFR 1.47(a) applicants' burden in showing that an inventor refuses to cooperate is explained in section 409.03(d) of the MPEP, *II. Refusal to Join*. Several pertinent segments are listed below:

A refusal by an inventor to sign an oath or declaration when the inventor has not been presented with the application papers does not itself suggest that the inventor is refusing to join the application unless it is clear that the inventor understands exactly what he or she is being asked to sign and refuses to accept the application papers. A copy of the application papers should be sent to the last known address of the non-signing inventor, or, if the nonsigning inventor is represented by counsel, to the address of the nonsigning inventor's attorney . . .

Where a refusal of the inventor to sign the application papers is alleged, the circumstances of the presentation of the application papers and of the refusal must be specified in a statement of facts by the person who presented the inventor with the application papers and/or to whom the refusal was made . . .

Petitioners provided a copy of an email from the nonsigning inventor dated 03 July 2008 requesting compensation for his signature on patent documents. This may constitute a written refusal to cooperate. However, in order for the refusal to be accepted, petitioners must show that Mr. Ammardji was provided (or an attempt was made to provide) a complete copy of the subject application.

Here, the 37 CFR 1.47(a) applicants have not demonstrated that a complete copy of the application including specification, claims and drawings were sent to Mr. Ammardji. The declaration by Ms. Pac and accompanying exhibits show only that a declaration was provided to Mr. Ammardji. Petitioners must show that at a minimum, an attempt was made to present the application papers to the nonsigning inventor for a refusal to be accepted.

For this reasons, item (2) of 37 CFR 1.47(a) is not yet satisfied.

CONCLUSION

Applicants' petition under 37 CFR 1.47(a) is DISMISSED without prejudice.

10/583,845

If reconsideration on the merits of this petition is desired, a proper response must be filed within **TWO (2) MONTHS** from the mail date of this decision. Extensions of time are available. No additional petition fee is required.

Any further correspondence with respect to this matter may be filed electronically via the USPTO EFS-Web or if mailed addressed to Mail Stop PCT, Commissioner for Patents, Office of PCT Legal Administration, P.O. Box 1450, Alexandria, Virginia 22313-1450, with the contents of the letter marked to the attention of the Office of PCT Legal Administration.

A handwritten signature in black ink that reads "James Thomson". The signature is written in a cursive, flowing style.

James Thomson
Attorney Advisor
Office of PCT Legal Administration

Tel.: (571) 272-3302